

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 3-41, 44-46 and 49-51 are pending, Claims 49-51 having been amended by way of the present amendment. Support for the present amendment is found in the specification, for example, at page 4 [0012] describing a “site-hostable” device for electronic document discovery, and Figures 4 and 7. Thus no new matter is added.

In the outstanding Office Action, Claim 51 was rejected under 35 U.S.C. § 101; Claims 3-4, 8, 14, 17, 20, 22, 23, 25, 27, 39, 44, 45-46 and 49-51 were rejected under 35 U.S.C. §103(a) as being unpatentable over Maxham, et al. (U.S. Patent Publication No. 2004/0187075, hereinafter Maxham) in view of Krachman (U.S. Patent No. 6,738,760); Claims 5-7, 26 and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Maxham, in view of Krachman and in further view of Koppich (U.S. Patent Publication No. US 2005/0141028); Claims 9 and 10 were rejected as being unpatentable over Maxham and Krachman in further view of Shaughnessy et al. (U.S. Patent Publication No. 2004/0205664, hereinafter Shaughnessy); Claim 11, 19 and 21 were rejected as being unpatentable over Maxham in view of Krachman, and in further view of Howard (U.S. Patent No. 6,098,079); Claim 12 was rejected as being unpatentable over Maxham in view of Krachman and in further view of Darren Chi (U.S. Patent No. 5,978,917, hereinafter Chi); Claim 13 was rejected as being unpatentable over Maxham, Krachman, Chi and in further view of Kumashio (U.S. Patent Publication No. 2004/0193631) and Howard; Claims 15 and 16 were rejected as being unpatentable over Maxham, Krachman, Shaughnessy and in further view of Riss et al. (U.S. Patent Publication No. 2004/0103367, hereinafter Riss); Claim 18 was

rejected as being unpatentable over Maxham, Krachman and in further view of Eagle et al. (U.S. Patent Publication No. 2003/0145209, hereinafter Eagle); Claim 24 was rejected as being unpatentable over Maxham, Krachman, Howard and in further view of Gladney (U.S. Patent Publication No. 2003-0131241); Claims 28, 40 and 41 were rejected as being unpatentable over Maxham, Krachman and in further view of Krachman (U.S. Patent Publication No. 2004-0199555, hereinafter Krachman II); Claims 29, 30, 31, 32 and 35 were rejected as being unpatentable over Maxham in view of Krachman and in further view of Kenner et al. (U.S. Patent No. 6,421,726, hereinafter Kenner); Claims 33 and 34 were rejected as being unpatentable over Maxham, Krachman, Kenner and in further view of Black et al. (U.S. Patent Publication No. 2002/0059317, hereinafter Black); Claim 36 was rejected as being unpatentable over Maxham, Krachman, Kenner and in further view of McIver (“Autovue Solid Model Professional Version 15”, hereinafter McIver); and Claim 37 was rejected as being unpatentable over Krachman, Kenner, McIver in further view of “Windows Tips-How to Create a File Association For Your Programs, Using the Registry”, hereinafter Windows.

In reply, the Title has been amended as requested.

Claim 51 has been amended to define a computer readable medium that includes instructions that when executed by a processor control the computer to perform steps as claimed. Consistent with the U.S. PTO’s “New Interim Patent Subject Matter Eligibility Examiner Instructions”, of August 24, 2009, the U.S. PTO recognizes a claim to a non-transitory, tangible computer readable storage medium that possesses structural limitations under the broadest reasonable interpretations to be patent eligible subject matter. In particular, the examination guidelines indicate adding an additional claim limitations to the

medium such as executable instructions would not render the medium non-statutory. Thus, it is respectfully submitted that Claim 51, as amended, complies with 35 U.S.C. §101.

As a preliminary matter, the comments made by the Office at paragraph 22 of the Office Action, are relevant as they provide insight into how the Office is construing the presently pending claims. Paragraph 22 of the Office Action states that the claim is directed to a device that loads data at a user site and that the working copy is done in a physical location in which the original data was physically located, was deemed moot by the Office based on the combination of Maxham in view of Krachman. Applicants respectfully traverse the Office's characterization of the presently pending claims and that Maxham and Krachman disclose all the claimed features.

Claim 49, as amended, is directed to a method of processing and converting electronically-stored data for electronic discovery in support of litigation. The method includes certain steps such as physically loading and copying data and associated metadata and to a processor-based device by a user, said processor-based device being located at the user site. The method also includes steps of inputting from the user, converting with the processor-based device a selected file, processing and converting with the processor-based device that select the file and, outputting the output file in the user-specified export format. Claim 49 has also been amended to make absolutely clear that the steps of physically loading and copying, inputting, converting, processing and converting, and outputting are performed on the processor-based device at the user site. This feature is relevant and distinguishing from the asserted prior art.

Applicants recognized that a deficiency with existing systems is that conventional systems require the entire contents of an archive to be copied and sent to a remote facility for the processing performed in Figure 1 (see page 3 [0008]). The present inventors also

recognized that economic advantages, operational efficiencies, and enhanced privacy/security associated with having an automated tool that can (a) be hosted at the facility in which the archives are located and (b) be operated by the people knowledgeable about the content in the local archives (page 3 [0008]).

For convenience, attached is a diagram of an implementation of Applicant's commercial device, Cricket Box, that shows the advantages of having in a device hostable at a user-site that can perform adaptable document production at the user's site, under user control.

The basis for the rejection of Claim 49 is that Maxham allegedly discloses all of the elements of Claim 49, except for the inputting from the user on-site user input to the processor-based device (see Office Action at page 5). The Office Action relies on Krachman to cure this deficiency with regard to Maxham.

Applicants traverse this rejection and traverse the Office's characterization of Maxham.

Claim 49 as amended expressly requires that the processor-device be located at the user-site and that all of the steps in the claimed process be performed on the processor-device at the user-site.

Maxham, on the other hand, operates on a completely different principle, which relies on a "cluster computing" (see Abstract). Maxham explains that:

"in accordance with the novel concepts discussed herein, electronic documents may be maintained by a computer cluster. Computer systems of this nature are easily scalable, allowing the addition of new nodes including one or more computer clusters when more storage capacity and computer power is needed. Also, these types of computing systems are redundant. If a cluster fails, the computer system remains functional. Other advantages of cluster computing will be discussed further herein" [0027].

Furthermore, Maxham distinguishes standalone devices that are not part of clustered computers by explaining that “while a PC or server may be used to manage a relatively small set of documents, storage and computing capacity becomes a major limitation when managing a large set of documents, especially if enhanced searching capabilities are implemented” [0027]. In order to provide this scalability, the computer system 10 (Figure 1) uses a cluster arrangement [0028]. A separate standalone workstation such as computer 12 may be used to access files on the computer system 10. However, it is computer system 10 that is configured to manage the large set of documents for multiple clients. By using the cluster arrangement uploaded documents are distributed to each node N_1-N_n of the computer system so that searching can be done in parallel [0039]. In order to avoid different users from having security issues and exposure to release of confidential or privileged documents, a web page is used such as shown in Figure 4 that allows a user to log on to the computer system 10 via the Internet [0047]. Therefore, Maxham is directed to a system that provides a web based searching, retrieving and electronic document management system that requires cluster computers at a remote site. Access is provided to multiple users at different sites from web browsers, so that multiple users may be able to use this system. When enhanced processing demands are needed, the system allows for the addition of additional processing nodes to handle the increased demand of the cluster computer system.

Krachman, the secondary reference, is directed to a device that uses smart search agents and artificial intelligence to help perform searching on a database having documents that may be subject to “discovery”. Krachman is directed to using artificial intelligence techniques and searching techniques to identify such documents (see, e.g., column 2, generally). The Office Action relies on Krachman in its rejection of Claim 49 as disclosing “inputting from the user on-site user input (deployed on the target computer by either the

requester 28 or the respondent 29 to said processor-based device)". (Office Action, page 5). The Office Action then relies on Krachman disclosing a system where inputs and loading are done on a local system (Figure 2) and that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have applied Krachman's disclosure for the purpose of allowing an administrator/user to use the same machine and further allow a search of data on any network database. The end result would be for convenience of faster loading and inputting rather than having an extra step of remotely sending information to be processed. In summary, the Office Action is rejecting Claim 49 on the premise that the local system aspects of Krachman, where data is input and used for searching, may be applied to Maxham so as to convert Maxham into a local machine hosted on a user's site. Applicants traverse this reasoning because converting Maxham into a processor based device at a user site, would render it unfit for its intended purpose of providing a scalable system that not only would be able to accommodate multiple users, but would also provide redundancy by nature of the computer cluster [0027]. Moreover, by Maxham's system of allowing multiple users to use the web-based resources accessible by way of a web browser, would make it logically impossible for different users to have the same processor-device hosted at their different user sites. Moreover, if one user has the hypothetical Maxham/Krachman machine at their site, then the second user cannot also have the same device at a different site. Furthermore, Maxham relies on the use of computer clusters, while Claim 49 requires that each of the steps of Claim 49 are performed on the processor-based device at the user site, thus precluding the use of clustered computers.

Also, the nature of the teaching in Maxham is highly relevant in that it is encouraging a centrally-based system that is web accessible by the Internet for the purpose of performing document processing on multiple computer nodes in a computer cluster. The claim precludes

cluster computing, as well as a centrally based web accessible system for use by multiple users. The Office Action is relying on a hypothetical combination of Krachman with Maxham to make the guess that such a device would be suitable. Such rationale is improper in making an obviousness rejection, since M.P.E.P. §2146 indicates that it is improper to combine references where the references teach away from their combination. Such is the case with Maxham, which explains that a PC or a server can only manage a relatively small set of documents and in contrast, “in accordance with the novel concepts discussed herein, electronic documents may be maintained by a computer cluster”. Thus, based on the teachings of Maxham, Maxham cannot reasonably be modified to be hosted on a single processor based device, when Maxham explains that its novel concepts are in the user of a computer cluster accessible to multiple users [0027]. Thus, it is respectfully submitted that the present rejection of Claim 49 is based on an improper reading of how Maxham can be converted via adoption of some features in Krachman in light of the teachings of Maxham.

Consequently, it is respectfully submitted that Claim 49, as amended, patentably defines over the asserted prior art. Although of differing statutory class and/or scope, it is respectfully submitted that Claims 3-4, 8, 14, 17, 20, 22, 23, 25, 27, 39, 44, 45-46 and 50-51 also patentably define over Maxham in view of Krachman for the reasons discussed above with regard to Claim 49.

Each of the other pending rejections are based on the combination of Maxham in view of Krachman and a tertiary or quaternary reference. These tertiary or quaternary references do not cure the deficiency discussed above with the Office’s reasoning in rejecting Claim 49, as amended. Consequently, it is respectfully submitted that each of the other dependent claims also patentably defines over the asserted prior art for at least the same reasons discussed above with regard to Claim 49.

Consequently, in view of the present amendment and in light of the foregoing comments it is respectfully submitted that each of the pending Claims 3-41, 44-46 and 49-51, as amended, is patentable eligible and patentably distinguishing over the prior art. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

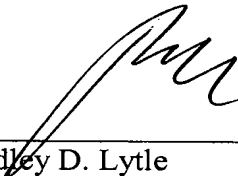
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